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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,977	08/11/2000	Richard Murray	A-68110-1/DJB/JJD	8486

7590 03/27/2002

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EXAMINER
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YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/637,977

Applicant(s)

MURRAY ET AL.

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5 and 11 are, drawn to a method of screening for drug candidates and/or bioactive agents, wherein the drug is capable of binding, modulating or interfering with angiogenesis modulator proteins, classified in class 436, subclass 94.
  - II. Claims, 6 and 7 are drawn to methods of evaluating the effects of an angiogenesis candidate drug, classified in class 436, subclass 501.
  - III. Claim 8 is, drawn to a method of diagnosing angiogenesis, classified in class 436, subclass 500.
  - IV. Claims 9 and 10 are, drawn to a biochip comprising nucleic acids, with fewer than 1000 nucleic acid probes, classified in class 514, subclass 44.
  - V. Claims 12 and 13 are, drawn to a methods of inhibiting the activity of an angiogenesis modulator protein (AMP), comprising the binding of an antibody, classified in class 514, subclass 2.
  - VI. Claims 14-16 and 31-33 are, drawn to a methods of treating disorders associated with angiogenesis and of neutralizing effects of AMP, wherein said method involves an antibody or an agent specific for AMP, classified in class 514, subclass 2.

- VII. Claims 17-19 are, drawn to methods of localizing a therapeutic moiety to angiogenesis, classified in class 436, subclass 513.
- VIII. Claim 20 is, drawn to a method of inhibiting angiogenesis in a cell comprising the administration of antisense molecules , classified in class 435, subclass 6.
- IX. Claims 21-24 are, drawn to an antibody, classified in class 424, subclass 131.1.
- X. Claims 25-26 are, drawn to a nucleic acid sequence, classified in class 536, subclass 23.1.
- XI. Claim 27 is, drawn to a polypeptide, classified in class 530, subclass 300.
- XII. Claims 28-29 are, drawn to a method of eliciting an immune response with a polypeptide or a nucleic acid, classified in class 424, subclass 184.1.
- XIII. Claim 30 is, drawn to a method of determining the prognosis of an individual by determining the level of AMP, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I-III, V-VIII, XII-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are materially different methods which have different modes of operation, function, and effects. The inventions of group I-III, V-VIII, XII-XIII are methods which are not required for one another, they are either

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screening methods (group I), evaluation methods (group II), methods for diagnosis (group III), methods of using drugs or compounds (groups V, VI and VIII), methods to cause an immune response (group XII) and a method for prognosticating, all of which are unrelated in purpose and function.

3. Inventions IV, IX-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are used for different functions and have different effects. The invention of groups IV and IX-XI are materially distinct products that each have different structural and functional elements.

4. Inventions I-III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus that is used in the methods of group I-III can be used to perform other methods, such as in the examination of non-drug related experiments, where gene expression profiles are needed.

5. Inventions IV and V-VIII, and XII-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to an unrelated apparatus and unrelated processes. The invention of group IV is drawn to a biochip

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which is not related to the processes of groups V-VIII, and XII-XIII, in that the processes do not involve the use of a biochip of group IV.

6. Inventions IX-XI and I-III, V-VIII, and XII-XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products as claimed can be used for different processes. The invention of group IX-XI, drawn to an antibody, nucleic acid and polypeptide, can be used for other purposes, other than those set forth in the inventions of groups I-III, V-VIII, and XII-XIII. For example, the antibody (group IX), the nucleic acids (group X) and the polypeptides (group XI) can be used to as tools to mark, diagnose, and treat diseases associated with other diseases other than those described in the instant application.

7. Because these inventions are distinct for the reasons given above and the search required for the different groups are not required for each other, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be

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accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
GEETHA P. BANSAL  
PRIMARY EXAMINER

Christopher Yaen  
Art Unit 1642  
March 12, 2002